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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,274	09/11/2003	Jerome Swartz	044XXG	4994

7590

05/18/2004

Kirschstein, Ottinger, Israel & Schiffmiller, P.C.  
489 Fifth Avenue  
New YORK, NY 10017-6105

EXAMINER
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ST CYR, DANIEL

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

10/660,274

Applicant(s)

SWARTZ ET AL.

Examiner

Daniel St.Cyr

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 September 1103.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Receipt is acknowledged that this case is a division of the application 10/059,552, filed 01/29/02, Patent No. 6,648,227, which parent is application No. 08/141,342, filed 10/25/93.
2. Receipt is also acknowledged of the pre-amendment filed 9/11/03 in which claims 1-30 were canceled and claims 31-38 were filed.

#### *Specification*

3. The specification is objected to because on page 1, first paragraph, the application should include that --This application is a division of application 10/059,552, filed 01/29/02, now Patent No. 6,648,227--. Correction is required.

#### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 31-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,648,227 (hereinafter '227 Patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somehow a broader recitation of the

'227 Patent. For instance in claim 1 of the present application and the '227 Patent, the applicants claim:

i)" A scan module for scanning indicia to be electro-optically read, the module comprising:

- a) a generally planar substrate;
- b) a raised support mounted on the substrate;
- c) a scan element mounted on the substrate for reflecting light incident on the scan element;
- d) a light source mounted on the raised support at an elevation above the scan element, for emitting a light beam in a direction parallel to the substrate; and
- e) optics mounted on the substrate between the light source and the scan element, for focusing and deflecting the light beam to the scan element for reflection therefrom away from the substrate as a focused scanning beam across the indicia."

Whereas in the '227 Patent, the applicant claim:

ii)" A scan module for scanning indicia to be electro-optically read, the module comprising:

- a) a substrate having a generally planar substrate portion lying in a substrate plane, and a raised substrate portion elevated above the substrate plane;
- b) a scan element mounted on the raised substrate portion, and including an oscillatable scan mirror lying in a mirror plane inclined relative to the substrate plane;

c) a light source integrated with the substrate and the scan element, and operative for emitting a light beam in a direction parallel to the substrate plane to the scan mirror for reflection therefrom away from the substrate as an unfocused scanning beam; and

d) a focusing lens integrally connected to the substrate in juxtaposition with the scan mirror, and operative for focusing the unfocused scanning beam to enable the indicia to be scanned with a focused scanning beam.”

As to the claims 31-38 of the instant application, the ‘227 Patent meet all the limitations.

Thus, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims 1-9 of the ‘227 Patent as a general teaching for optical reading, to perform the same function as claimed in the present invention. The instant claims obviously encompass the claimed invention of the ‘227 Patent and differ only in terminology. The extent that the instant claims are broaden and therefore generic to claimed invention of ‘227 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from the claims in a first patent. IN re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. & 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. & 1.78(d).

*Allowable Subject Matter*

6. Claims 31-38 would be allowable upon filing a **terminal disclaimer**.

*Conclusion*

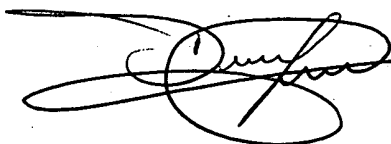
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Heemskerk et al, US Patent No. 4,358,200, disclose an optical focusing error detection system. Oinoue, US Patent No. 4,733,067, disclose a semiconductor laser apparatus for optical head. Yamazaki et al, US Patent No. 5,266,788, disclose a laser scanner for bar code reader having a transparent light guide plane. Floyd et al, US Patent No. 6,014, 240, disclose a method and apparatus for an integrated laser beam scanner using a carrier substrate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel St.Cyr



5/07/04